

REMARKS

Claims 1-19 pending in the application.

Claims 1-19 are rejected.

Claims 1, 5, 7, 9, 13-16 and 18-19 are amended.

New Claim 20 is added.

In the Drawings

The drawings were objected to because they did not show all of the features of the invention as claimed. More specifically, with regard to Claims 1, 5 and 13, the drawings did not show a single sheet of material adhere to one another, as claimed. Applicants have amended Claims 1, 5 and 13 in order to clarify that with respect to Claims 5 and 13, the invention includes multiple pages or sheets that are magnetically adherable to one another.

Based on the amendments to the claims, all of the features of the claimed invention are believed to be shown in the drawings. Accordingly, the objections to the drawings are believed to be overcome.

35 USC 112 First Paragraph Rejections

The action states that the features of Claims 5 and 13 are not explained in the specification so as to enable a person skilled in the art to make use of the invention. Applicants refer the Examiner to page 6 starting at line 18 and continuing through page 7, line 8 of the specification. Applicants believe that the description of the invention at the cited section is sufficient to overcome the Section 112, first paragraph rejections with respect to Claims 5 and 13.

35 US 112 Second paragraph Rejections

Claims 1-19 were rejected under 35 USC Section 112, second paragraph. Claims 1-8 and 18 claim an apparatus for use within a stationary cabinet. Applicants respectfully submit that language that references the cabinet in the claim is proper in that such language sets out the environment for usage of the

invention. Applicants analogize the situation to claims directed toward a piece of equipment such as a mobile device that operates in connection with a base station in a telecommunications network. An applicant may claim certain features of the mobile device as it operates in connection with the base station. Surely, however, the applicant is not required to claim the base station and the communications network in such a situation. Applicants submit that references to the cabinet are proper in Claims 1-8 and 18, since the language more clearly defines the environment for operation of the invention.

As to Claims 9-17 and 20, applicants have amended the claims to additionally claim a cabinet such that the claims stand as a combination. Claim 19 is also believed to include satisfactory language, since it is a method claim.

Regarding Claims 3 and 5-8, the Section 112 rejections are believed to have been addressed with regard to single sheets and multiple sheets.

Prior Art Rejections

All pending claims in the application have been rejected under 35 USC §103(a) as being obvious in view of Baily (U.S. Patent No. 1,326,832) and Leppke (U.S. Patent No. 1,624,741), and further in view of other references with regard to certain claims.

Applicants respectfully request withdrawal of the Examiner's rejections regarding Claims 1-19. Applicants submit that the present invention, as set forth in the claims, is non-obvious in view of the combination of cited references, since a person skilled in the art would not be motivated to combine the references in the manner suggested by the Examiner. In addition, the claims are believed to be distinguishable over the cited references, since all of the limitations of the claims as presented are not found in the cited references even if combined as suggested.

Briefly, applicants were the first to devise a manner to include an easily accessible memo board having multiple pages that is mountable in out of sight

location such as a stationary cabinet. Applicants' invention is novel and non-obvious because other memo boards do not include multiple rotatable pages having magnetically adhereable surfaces that are mountable in a hidden fashion as described by the invention, as well as other novel features included in the claims.

Applicants respectfully submit that the Examiner has not set forth a proper case for rejecting the claims under 35 USC Section 103 of the Patent law. In independent Claims 1, 9, 18 and 19, for example, applicants generally sets forth an apparatus (a memo board apparatus) for use in connection with a stationary cabinet having shelving therein, wherein magnets are attachable to sheets of the apparatus and the sheets are rotatable within the cabinet when the door thereto is opened. The primary reference relied upon by the Office Action is a portable exhibiting apparatus disclosed in Baily, which is combined with Leppke for the principle of including sheets that are attachable by a magnet. Applicants respectfully submit that there is no suggestion in the Baily reference to include magnetically attachable pages as is required by the law in order to combine the references. The critical inquiry in determining obviousness is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" ***Fromson v. Advance Offset Plate, Inc.***, 225 USPQ 26, 31 (Fed. Cir. 1985) quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d at 1462, 221 USPQ at 488. In the instant case, such a suggestion is not present. Moreover, applicants submit that a person skilled in the art of developing design improvements for stationary cabinets would not look to the art of portable exhibiting devices in order to research improvements for stationary cabinets. Accordingly, the combination Baily and Leppke is believed to be an improper combination under Section 103(a).

Additionally, even if the references were combined as suggested in the Office Action, the proposed combination still does not include limitations directed

toward the mounting of a rotatable memo board apparatus within a stationary cabinet as claimed.

With regard to dependent Claim 6 applicants again submit that it would not have been obvious to also include a surface on which one can write with non-permanent markers in the context of the device as claimed in Claim 1, since there is no suggestion to combine the three references in that manner.

Additionally, with respect to Claim 5 (which has been amended to depend from Claim 6), applicants disagree that a strap fastener as detailed in the Devall reference is an analogous design choice substitute for magnetically adherable sheets of material that can be magnetically fastened to one another. Applicants have set forth a much more elegant and efficient method enabling the multiple pages to attract to one another so that they may hold together as a unit, if desired. This feature is distinguishable and believed not to be obvious in view of the references as cited. Moreover, in order to purportedly meet all the limitations of Claim 5, four separate references would need to be combined, which further serves to bolster applicants' argument of non-obviousness.

The above argument with regard to the magnetically adherable sheets is also applicable with respect to Claim 13.

Applicants also bring to the Examiner's attention a prominent CCPA decision addressing obviousness under Section 103, here the court stated that "[I]t should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103." *In re Nomiya*, 184 USPQ 607, 612 (C.C.P.A. 1975).

Applicants readily admit that certain separable elements of the claimed invention can be termed as "old". "There is no basis in the law, however, for treating combinations of old elements differently in determining patentability. . . . The critical inquiry is whether 'there is something in the prior art as a whole to

suggest the desirability, and thus the obviousness, of making the combination.” ***Fromson v. Advance Offset Plate, Inc.***, 225 USPQ 26, 31 (Fed. Cir. 1985) quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d at 1462, 221 USPQ at 488. Applicant respectfully submits, as is stated by the Nomiya court that “[t]here must, however, be a reason apparent at the time the invention was made to the person of ordinary skill in the art for applying the teaching at hand, or the use of the teaching as evidence of obviousness will entail prohibited hindsight.”

“One of the more difficult aspects of resolving questions of non-obviousness is the necessity ‘to guard against slipping into use of hindsight.’ . . . Many inventions may seem obvious to everyone after they have been made. However, 35 USC 103 instructs us to inquire into whether the claimed invention ‘would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” ***In re Carroll***, 202 USPQ 571, 572 (C.C.P.A. 1979) (quoting ***Graham v. John Deere Co.***, 383 U.S. 1, 36 (1965))

Applicants respectfully submit that the Examiner may be applying an “obvious to try” test in making his Section 103 rejections. However, this is not the standard of the law. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” ***In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ 2d 1780, 1783–84 (Fed. Cir. 1992). In the case of the present invention, the prior art simply does not suggest the desirability of modification in order to reach applicant’s invention.

Based on the above remarks and the amendments to the claims, applicants submit that the claims have been shown to be allowable in view of the prior art and that the basis for any rejections has been overcome.

Conclusion

Having fully addressed the Examiner's rejections it is believed that, in view of the preceding remarks, this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, it is respectfully requested that the Examiner contact the applicants' attorney at (908) 582-7584, so that a mutually convenient date and time for a telephonic interview may be scheduled.

Please address all written correspondence to:

9 Cross Brook Drive
Califon, New Jersey 07830

Respectfully submitted,



Matthew J. Hodulik
Reg. No. 36,164

Dated: October 27, 2006

Certification of First Class Mailing

I hereby certify that this correspondence (and any paper referred to as being transmitted therewith) is being deposited in the United States Postal Service as first class mail in an envelope with sufficient postage addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on the date indicated below:

October 27, 2006

Date



Matthew J. Hodulik